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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BRAHAN, THOMAS J

ART UNIT

PAPER NUMBER

3652

DATE MAILED: 09/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,369

Applicant(s)

MUNNEKEHOFF

Examiner

Thomas J. Brahan

Art Unit

3652



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 23, 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 24, and 25 is/are rejected.
- 7) ☒ Claim(s) 5 and 7-23 is/are objected to.
- 8) ☒ Claims 1-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 6) ☐ Other:

1. The disclosure is objected to because of the following informalities. Page 14, line 25 refers to a brake 20 which is shown in figure 9. However the disclosure lacks a figure 9. It also appears as though the term "[sic]" in line 26 is something added by the translator. The term is used on other pages of the specification when the translator could not translate. The entire specification should be reviewed for errors. The specification is replete with awkward sentences, such as at the bottom of page 14 "Arranged in the spring chamber 26, around the load-bearing element 5, are at least two blocking elements 27, which, in the configuration illustrated, are balls in particular." A substitute specification is suggested.

2. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- I. Claims 1-23, drawn to a load lifting apparatus, classified in Class 212, subclass 331.
- II. Claims 24 and 25, drawn to a method of controlling a load lifting apparatus, classified in Class 212, subclass 270.

3. The inventions are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this application, apparatus as claimed, can be used in a materially different process which does not involve torque signals. Note that the specification at page 9, lines 5-8, recites that the system of figure 2 can be "used without a regulating circuit for load-balancing purposes to be speed-controlled directly via the manipulation force F".

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. This application also contains claims directed to the following patentably distinct species (of lifting arrangements) of the claimed invention:

- Species I, shown in figure 1.
- Species II, shown in figures 6 and 7.
- Species III, shown in figure 8.
- Species IV, having a rack load bearing element, not shown in the drawings.

6. This application also contains claims directed to the following patentably distinct sub-species (of handling devices) of the claimed invention:

Sub-species 1 shown in figure 4.

Sub-species 2 shown in figure 5.

7. This application also contains claims directed to the following patentably distinct sub-sub-species (of devices for generating path-dependent signals) of the claimed invention which are listed in the claims as corresponding to the angle of rotation of a drum, angle of rotation of a sub-arm, an incremental encoder for a drum, an incremental encoder for a drive shaft, an incremental encoder on a deflecting disk, an incremental encoder at a pivot axis of a parallelogram joint. It appears as though some of these controls are only used with specific lifting arrangement, but this is not clear from the disclosure.

8. Applicant is required under 35 U.S.C. § 121 to elect a single invention, a single species of lifting arrangements, a single sub-species of handling devices, and a single sub-sub-species of control signal generators, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, only claim 1 appears to be generic.

9. Applicant is advised that a response to this requirement must include an identification of the invention and the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

10. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

11. Should applicant traverse on the ground that the species or sub-species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of

the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

12. To expedite prosecution, an action on the merits of both inventions follows.

13. Claims 5 and 7-23 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim can depend from another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims not been further treated on the merits.

14. The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the rack of claim 4 and the storage battery of claim 21 must be shown, or the features must be canceled from the claims. No new matter may be entered.

15. The following is a quotation of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which applicant regards as his invention.

A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the claimed subject matter. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

An element in a claim for combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

16. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate description of the claimed invention. It is unclear as to how the applicant is considering the device as generating a "path-dependent" control signal. The specification, as best understood, does not have a characteristic of a path as factor for determining the control signals. The function of the setting member (16) with respect to controlling a transmission is also unclear from the specification. More details of the setting member are listed in claim 12 than in the specification.

17. Claims 1-4, 6, 24, and 25 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

18. Claims 1-4 and 6 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. For example:

- a. In claim 1, it is unclear as to what would be considered as a path dependent signal. This term is vague, and does not appear to correspond to the torque value disclosed in the specification.
- b. In claim 2, lines 4 and 5, the phrase "in particular, as an electric servomotor" fails to positively recite the claimed structure of an electric servomotor.
- c. In claim 3, lines 3-5, the phrase "such as a pneumatic piston/cylinder unit arrangement or a pneumatically activated recirculating ball screw" fails to positively recite these structures.
- d. In claim 4, lines 3 and 4, the phrase "e.g. as a rack" fails to positively recite the claimed structure of the rack. It is also unclear as to how the rack structure would be combined with the pneumatic drives of claim 3.

19. Claims 24 and 25 are rejected under 35 U.S.C. § 112, second and fourth paragraphs, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, and for failing to further limit the invention of the claims from which these claims depend. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear

to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. The scope of claim 24 is unclear. The limitation "in particular by means of a system as claimed in one or more of claims 1-23" renders the claims indefinite. It is improper for a method claim to depend from an apparatus claim as the scope of the claim would be indeterminable. It is unclear as to what structures of the claims 1-23, if any, would be considered as part of the claimed invention. Note also that the phrase "in particular" fails to positively include the structure into the claimed combination. And if the phrase was read to positively include the structure of the apparatus claims, the apparatus claims are listed improperly, as a multiple dependent claim must depend from the claims in the alternative, and must not depend from another multiple dependent claim.

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

21. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.


Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

22. Claims 1, 2, 4/1, 4/2, 6/1, 6/2, 24 and 25, as best understood, are rejected under 35 U.S.C. § 102(b) as being anticipated by Kahlman et al, see column 6, lines 46-64.

23. Claims 1, 3, 4/3, and 6/3, as best understood, are rejected under 35 U.S.C. § 102(b) as being anticipated by Kulhavy. The centrifugal signal of Kulhavy is considered as a "path-dependent" control signal, as the term is best understood.

24. Klimo, Kornerly, and Kazerooni are cited as showing hoist arrangements with similar control features.

25. An inquiry concerning this action should be directed to Examiner Thomas J. Brahan at telephone number (703) 308-2568 on Mondays through Fridays from 9:30-7:00 EST. The examiner's supervisor, Ms. Eileen Lillis, can be reached at (703) 308-3248. The fax number for Technology Center 3600 is (703) 305-7687.

 9/6/02
THOMAS J. BRAHAN
PRIMARY EXAMINER